

REMARKS

The Examiners, Mr. Pendergrass and Mr. Poon, are thanked for the courtesy of the interview granted Applicant's attorney on December 17, 2004. During the course of the interview, some of the claims were discussed in comparison to the applied prior art. In particular, Applicant's attorney focused on the fact that each of the independent claims involved transmitting the password to a designated addressee by electronic mail. Applicant's attorney also advised the Examiners that the combinations represented by the pending claims were not taught or suggested in any of the prior art.

Claims 1-12 of the present application have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,438,574, hereinafter *Nagashima*, and U.S. Patent No. 6,519,048, hereinafter *Tanaka*. The Examiner relies upon *Nagashima* for its alleged teaching of a system connected by a network that scans an image, produces a password, transmits the image data to a designated printer, and performs printing on the basis of the image data. The Examiner alleges that *Nagashima* also teaches an image forming device that includes a receiving unit which receives a password and a controller which controls the image forming unit based on whether the set password is received or not. As acknowledged by the Examiner, in *Nagashima*, the password is stored on an ID card. To determine if the password is correct, the ID card is inserted into a controller. The Examiner acknowledges that *Nagashima* does not teach receiving designation of an email addressee nor, transmitting the password or certification information to the designated addressee by email.

To overcome this deficiency, the Examiner relies upon *Tanaka*, and alleges that *Tanaka* teaches the designation of an addressee and transmitting the password to the designated addressee by email. In support of this position, the Examiner refers to column 11, lines 36-39 of *Tanaka*. However, the cited portion of *Tanaka* relates to the fourth embodiment. In this embodiment, discussion is had of providing notice of the result of the printing operation. Specifically, at column 11, lines 39, the specification discusses the notice data generator 105. The notice data generator 105 is described in more detail at column 6, line 66 through column 7, line 9. As explained at that section, the notice data generator generates data to notify of a status of the print job. The status can be in the form of status information showing whether the resource to be printed could be normally downloaded, or whether the print could be normally performed or whether it failed in the print engine. The status information is intended to advise the client whether or not the print succeeded or failed. Turning attention back to column 11, the fourth embodiment indicates that the notice data generator generates a print result which can be opened only by a password that is transmitted by email. However, the password transmitted by e-mail appears to relate only to opening the print result, and not printing the main document at issue. Accordingly, *Tanaka* does not teach or suggest a system wherein printing of a document is enabled by a password or certification information which is transmitted to an addressee by email.

The present invention is advantageous over the prior art in that because the password or certification information is transmitted by email, rather than being stored on an ID card, the password or certification information can be more quickly and

easily transmitted, especially over long distances. Thus, the present invention is more versatile than the applied prior art.

Each of the original claims defines either an image forming method, an image forming system, an image communicating apparatus, an image reading apparatus or an image communication method, each of which includes in one form or another transmitting a password to a designated addressee by email, wherein the password corresponds to image data. For example, according to claim 1, if the password transmitted by email is entered into the printer and the password matches the password transmitted together with the image data, the method includes performing printing on the basis of the image data.

As set forth above, none of the cited prior art teaches or suggests the claimed methods or systems or apparatus. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections of claims 1-12.

To further define the protection to which Applicants are entitled, new claims 13-15 have also been added. The new claims define image forming methods, each of which also includes transmitting certification information to a designated addressee by an email, wherein the certification information corresponds to image data, thus enabling printing of the image data. Accordingly, new claims 13-15 are also patentable over the applied prior art.

With regard to the motivation to combine *Nagashima* with *Tanaka*, Applicants further submit that the motivation required by 35 U.S.C. §103(a) is not present. The Examiner alleges that it would have been obvious to one skilled in the art at the time of the invention to have combined the image forming method of *Nagashima* with the teachings of *Tanaka*. The Examiner alleges that the *Tanaka* teachings enable the

output result of *Nagashima* print to be promptly, easily, and visually confirmed. It also allows transfer of status dated to the user, confirming a print result. Thus, as acknowledged by the Examiner, the only function enabled by the emailing of a password in *Tanaka* is to transfer the status data to the user. It does not enable printing of a document to be accomplished.

Accordingly, Applicants submit that there is no proper motivation to combine *Nagashima* with *Tanaka*.

In view of the foregoing amendments and remarks, the Examiner is respectfully urged to find claims 1-15 to be in condition for allowance. In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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